

REMARKS

Claims 16, 21-23 and 29-30 have been amended.

The Examiner has rejected applicants' claims 16-24, 26, 29 and 30 under 35 USC 102(b) as being anticipated by the Iwai, et al. (U.S. Pat. No. 5,175,681) patent. The Examiner has rejected applicants' claims 24 and 28 under 35 USC 103(a) as being unpatentable over the Iwai, et al. patent in view of the Lee (U.S. Pat. No. 7,016,851) patent. The Examiner has also rejected applicants' claim 27 under 35 USC 103(a) as being unpatentable over the Iwai, et al. patent. Applicants have amended applicants' independent claims 1, 21-23 and 29-30 and with respect to these claims, as amended, and their respective dependent claims, the Examiner's rejections are respectfully traversed.

Applicants' independent claim 16 has been amended to recite an information processing apparatus for processing electrical data sent from Patent Office, the electrical data including a first portion relating to a document issued at the Patent Office and a second portion relating to an application number of the document, comprising first storage means for storing a reception record of the document received from the Patent Office, second storage means for storing document data of the document, acquisition means for acquiring the application number from the reception record stored in the first storage means or the document data stored in the second storage means, a table storing data showing correspondence between the application number and an applicant, extraction means for extracting, for a plurality of different applicants, document data of the document stored in the second storage means and related to the application number by referring to the table using the application number obtained by the acquisition means as a key, and third storage means for storing the extracted document data in

relation to bibliographic data corresponding to the application number and the applicant.

Applicants' independent claims 21 and 22 have been similarly amended.

Applicants' independent claim 23 has been amended to recite an information processing apparatus for managing a document related to technical information, comprising first determination means for determining whether overseas transmission of said technical information is restricted based on whether a predetermined period has passed from filing, second determination means for determining whether overseas transmission of the technical information is restricted based on whether a predetermined permission has been obtained, and control means for controlling overseas transmission of the document depending on a determination result by the determination means. Applicants' independent claims 29 and 30 have been similarly amended.

The constructions recited in applicants' amended independent claims 1, 21-22 and 23, 29 and 30 are not taught or suggested by the cited art of record. With respect to applicants' claims 1 and 21-22, the Iwai, et al. patent does not teach or suggest processing electrical data sent from Patent Office, electrical data including a first portion relating to a document issued at Patent Office and a second portion relating to an application number of the document. The Iwai, et al. patent also does not teach or suggest extracting, for a plurality of different applicants, document data of the document stored in the second storage means and related to the application number by referring to the table using the application number obtained by acquisition means as a key. Specifically, the Iwai, et al. patent discloses a system for storing and managing data concerning prosecution of patent applications, which includes a master file (10) for storing basic data such as agents' names and addresses and country names, a rule data file (20) for storing a rule table and a table for setting and controlling times, such as due dates,

a case file (30) which stores data for each application, such as identification information, and a control data file (60). Col. 8, lines 22-52; Col. 9, lines 31-41. The system of Iwai, et al. requires manual input of data concerning the individual applications, such that data relating to the application, e.g. docket number, application number, etc., and data relating to any documents issued by the Patent Office, e.g. office actions, are inputted into the system by a user using a keyboard. See, FIG. 15, Col. 19, line 47-Col. 20, line 19; Col. 20, lines 33-60. There is no mention in Iwai, et al. of the management system, or the computer on which the system is used, receiving any electrical data from the Patent Office, with the electrical data including a data portion relating to a document issued at the Patent Office and a data portion relating to an application number of the document.

Moreover, the Iwai, et al. patent only discloses entering and storing in the case data file for each individual application data relating to the application and data relating to documents issued by the Patent Office, or the file history information. See, e.g. FIG. 15 and Col. 19, line 47 to Col. 20, line 19. The Iwai, et al. patent is completely silent as to extracting document data of a stored document and related to the application number for a plurality of different applicants. There is also no teaching or suggestion in Iwai, et al. of extracting the document data by using the application number as a key. Instead, Iwai, et al. teaches that the case data file (30) of each application is identified by the applicant's reference number, i.e. the docket number.

Accordingly, applicants' amended independent claims 16, 21 and 22, each of which recites an information processing apparatus or method for processing electrical data sent from Patent Office, the electrical data including a first portion relating to a document issued at a Patent Office and a second portion relating to an application number of the document, which

performs extracting, for a plurality of different applicants, document data of the document stored in the second storage means and related to the application number by referring to the table using the application number as a key, and their respective dependent claims, thus patentably distinguish over the Iwai, et al. patent. Moreover, the Lee, et al. patent, which discloses managing attorneys in different countries through a network when an application is filed in plural countries, adds nothing to change this conclusion and therefore, applicants' amended independent claims 16, 21 and 22 also patentably distinguish over the combination of the Iwai, et al. and the Lee, et al. patents.

With respect to applicants' amended independent claims 23 and 29-30, the Iwai, et al. patent does not teach or suggest determining whether overseas transmission of technical information is restricted based on whether a predetermined period has passed from filing and based on whether a predetermined permission has been obtained and controlling overseas transmission of the document based on the determinations. The Examiner has argued that the Iwai, et al. patent discloses determining a rule of law relating to overseas transmission of technical information by defining rules of law for processing a patent application overseas in col. 2, lines 54-63 and that Iwai, et al. discloses controlling the overseas transmission based on the determination result by disclosing that the data memory that stores the rules also controls the output of the technical information in col. 2, lines 29-35.

Applicants have reviewed the Iwai, et al. patent, and in particular the portions cited by the Examiner, and respectfully disagree with the Examiner's arguments. Specifically, the system in Iwai, et al. is completely unrelated to transmission of technical information overseas and to the rules that govern such transmissions. Instead, the system in Iwai, et al. includes a file for storing rule data, including information concerning required actions at each step of

prosecution of applications in each country where the application is filed. See, Col. 2, lines 25-37. More particularly, the rule data file of Iwai, et al. includes a variety of rules that define various steps during prosecution of applications and rules for controlling times, such as rules defining deadlines for filing responses and taking other actions during prosecution of applications. See, Col. 9, lines 31-Col. 11, lines 34.

The rule data file of Iwai, et al., thus, merely defines prosecution steps for prosecuting patent applications in various countries and time limits for taking various actions during prosecution, and is in no way equivalent to rules concerning restrictions on overseas transmission of technical information. Therefore, there is no teaching or suggestion in Iwai, et al. of controlling overseas transmission of documents depending on whether it is determined that overseas transmission of the technical information is restricted.

Moreover, there is no mention anywhere in Iwai, et al. of any rules that can be used to determine whether overseas transmission of technical information is restricted based on whether a predetermined period has passed from filing and determining whether overseas transmission of the technical information is restricted based on whether a predetermined permission has been obtained.

Accordingly, applicants' amended independent claims 23, 29 and 30, each of which recites the above features, and their respective dependent claims, thus patentably distinguish over the Iwai, et al. patent. Moreover, the Lee, et al. patent which discloses managing associates in different jurisdictions and transmission of technical information from an originating filer to associates in other jurisdictions, does not teach or suggest determining whether overseas transmission of the technical information is restricted based on whether a predetermined period has passed from filing and based on whether a predetermined permission

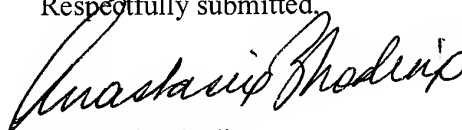
has been obtained. Therefore, applicants' amended independent claims 23, 29 and 30, and their respective dependent claims, are also patentable over the Lee, et al. patent, taken alone or in combination with the Iwai, et al. patent.

In view of the above, it is submitted that applicants' claims, as amended, patentably distinguish over the cited art of record. Accordingly, reconsideration of the claims is respectfully requested.

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COWAN, LIEBOWITZ & LATMAN, P.C.
1133 Avenue of the Americas
New York, New York 10036
T (212) 790-9200

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Anastasia Zhadina". The signature is fluid and cursive, with a large initial 'A'.

Anastasia Zhadina
Reg. No. 48,544
Attorney of Record